REMARKS

Reconsideration of the application is requested.

Claims 1, 3, 5-7 and 9-10 remain in the application. Claims 1, 3, 5-7 and 9-10 are subject to examination. Claims 2, 4 and 8 were previously canceled.

Under the heading "Claim Rejections - 35 USC § 103" on pages 2-6 of the above-identified Office Action, claims 1, 3, 6-7, 9 and 10 have been rejected as being obvious over U.S. Patent No. 5,461,921 to Papadakis et al. (hereinafter Papadakis) in view of U.S. Patent No. 5,721,783 to Anderson (hereinafter Anderson) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Papadakis teaches a test device particularly for testing the quality of materials. For the testing of materials a known test signal is sent through the material and the detected distortion of the test signal at the receiver side is a measure for evaluating the quality of the material.

The test signal is a continuous wave wide band direct sequence spread spectrum signal (see the abstract). The Examiner relies on Anderson for teaching the compression of voice data information and believes that the combination of Papadakis and Anderson teaches the invention of the instant application.

The proposed modification to Papadakis, adding signal compression, would not be done by one of average skill in the art for the now described reasons. The test signal received in the receiver is analyzed for any distortions it has suffered during the encounter with the test material. It should be kept in mind that Papadakis discloses as an objective to provide a reliable and predictable ultra sonic flow detection device. However, signal compression would decrease the reliability and predictability of the detection method due to the higher complexity needed for the analysis of the signal, e.g. the additional decompressing. Hence a person of average skill in the art would rather refrain from applying any compression to the test signal in Papadakis. More specifically, MPEP 2143.01 clearly states that the proposed modification cannot render the prior art unsatisfactory for its intended purposed. We believed that degrading the effectiveness of the invention in Papadakis to qualify as an unsatisfactory result.

Furthermore, signal compression would lead to no advantages, because by compression no additional information can be represented in the test signal, as the information in the test signal is not the signal itself but the distortion it suffered. Hence a person of average skill in the art would consider the application of compression to the teaching of Papadakis as superfluous and would only add cost and unnecessary complexity. Therefore one would not be inclined to add signal compression.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an

implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments and the resulting combination, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. More specifically no one of average skill in the art would make the combination because it would degrade the invention of Papadakis.

Furthermore, it is questionable whether the arts are analogous as there is no reason to combine documents from material analysis with documents concerning hearing aids

alone from the nature of the problem to be solved, which is cited as to provide a method for wireless transmission of data where can be implemented inexpensively and that provides a transmission rate necessary for transmitting digital voice data.

Accordingly, the examiner is respectfully requested to withdraw the rejection.

Under the heading "Claim Rejections - 35 USC § 103" on pages 2-6 of the above-identified Office Action, claim 5 has been rejected as being obvious over U.S. Patent No. 5,461,921 to Papadakis et al. (hereinafter Papadakis) in view of U.S. Patent No. 5,721,783 to Anderson (hereinafter Anderson) and further in view of U.S. Patent No. 4,591,811 to Nakamura under 35 U.S.C. § 103.

Claim 1 is believed to be allowable. Claim 5 depends from claim 1 and therefore is also believed to be allowable.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 7. Claims 1 and 7 are, therefore, believed to be patentable over the art.

The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1 or 7.

In view of the foregoing, reconsideration and allowance of claims 1, 3, 5-7 and 9-10 are solicited.

If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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REL:cgm

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